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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

MICHAEL REGAN

Application No. 10/824,668

Filed: April 14, 2004

For: INSULATED SUPPRESSOR FOR
INDUSTRIAL MAGNETRONS

: Docket No. 0404-04501US

: Art Unit 3742

: Confirmation No. 7533

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By *Vincent T. Pace*

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REPLY UNDER 37 C.F.R. §1.111

In response to the Official Action dated November 2, 2005, Applicant hereby elects to prosecute Claims 1 to 10 (Group I) as set forth in the Official Action. This election is made with traverse for the following reasons.

In making the restriction requirement, the Examiner explained that invention Groups I, II, and III are related as process of making and product made. The Examiner

then went on to explain that the invention groups can be shown to be patentably distinct if (A) the process as claimed can be used to make a materially different product or (B) the product as claimed can be made by a materially different process. The Examiner then concluded that the process as claimed can be used to make a radio frequency radiation suppressor with or without a metallic connector.

There Is No Proper Basis For Restriction Between Groups I and III

The Examiner failed to provide any explanation why the subject matter of the Group III claims is independent and distinct from the subject matter of the Group I claims. Such explanation is also missing from the Official Action mailed on July 12, 2005. MPEP 803 (II.) states that an Examiner must provide reasons or examples to support the conclusion that restriction is proper.

It is not readily apparent why the subject matter of the Group III claims is independent or distinct from the subject matter of the Group I claims. Indeed, the Examiner has admitted that the subject matter of the Group I and the Group III claims is classified in the same class and subclass. That admission provides a clear inference that the subject matter of the Group III claims is considered by the Patent and Trademark Office as not being independent or distinct from the subject matter of the Group I claims. Therefore, the Examiner's own evidence does not support a conclusion that the subject matter of the Group III claims is independent or distinct from the subject matter of the Group I claims.

Claims 1 and 16 differ only in scope because Claim 1 encompasses a suppressor that has a metallic connector. The Examiner's attention is directed to Claim 2 which includes a metallic connector in the radio frequency radiation suppressor of Claim 1.

For all of the foregoing reasons, the Examiner has failed to raise a *prima facie*

basis for requiring restriction between the claims of Groups I and III. Therefore, it is respectfully requested that the requirement be withdrawn and that Claims 16-20 be examined with Claims 1-10.

The Basis For Restriction Between Groups I, II, and III Is Improper

Set forth in the table below are the texts of Claims 1, 11, and 16 of the present application.

1. A radio frequency radiation suppressor for a magnetron, comprising

- a) an inner sleeve member made of an electrical insulating material, and
- b) an outer shell assembled to said inner sleeve member, said outer shell member being made of a material that absorbs radio-frequency radiation.

11. A method of making a radio frequency radiation suppressor for an industrial magnetron comprising the steps of:

- forming an inner sleeve from an electrically insulating polymer material; and
- forming a radio-frequency radiation absorbing outer shell on the inner sleeve.

16. A radio frequency radiation suppressor for a magnetron, comprising

- a) an inner sleeve member made of an electrical insulating polymer material;
- b) an outer shell assembled to said inner sleeve member, said outer shell member being made of a material that absorbs radio-frequency radiation; and
- c) a metallic connector attached to the inner sleeve member for contacting the

magnetron.

It is readily apparent that Claims 1, 11, and 16 share the common features of an inner sleeve member made of an electrical insulating material and an outer shell assembled to the inner sleeve member, the outer shell member being made of a material that absorbs radio-frequency radiation. "Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition." MPEP 806.03.

MPEP 803 (I.) reads as follows.

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP §802.01, §806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - §806.05(j)); and

(B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02).

Although there is some evidence that the process of Claims 11-19 is classified in a different subclass of class 219 from the products of Claims 1-10 and 16-20, the Examiner has not provided any reason why there would be a serious burden to examine all of the claims. Indeed, the proximity of the classifications of the two inventions would suggest that there would be no significant burden to examine all of the claims together. "If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." MPEP 803.

The Examiner has failed to raise a *prima facie* basis to support the requirement for restriction between the inventions defined in the claims of Groups I, II, and III.

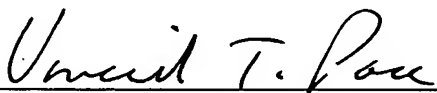
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Examiner Daniel L. Robinson
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Therefore, it is believed that the restriction requirement is improper. Accordingly, it is respectfully requested that the requirement for restriction be withdrawn and that Claims 11-20 be examined together with Claims 1-10.

Respectfully submitted,

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